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Appeal Brief
PATENT
7284/52829-R
Cyler
1-36-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : David G. Bird
Serial No. : 08/862,039
Filed : May 22, 1997
For : LOCATION OF MISSING VEHICLES
Group A.U. : 3662
Examiner : T. Blum

Appeal No.:
For Reissue of Original Patent
No. 5,418,537 issued May 23, 1995

I hereby certify that this paper is being deposited this date with the U.S. Postal
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January 16, 2001
Date

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BRIEF ON APPEAL

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This brief is submitted in triplicate pursuant to 37 C.F.R. 1.192(a) and is accompanied by
a fee of \$310.00 pursuant to 37 C.F.R. 1.17(c). Please charge any additional fee or credit any

overpayment to our Deposit Account No. 03-3125. An extra copy of this sheet is enclosed.

The following information is provided pursuant to 37 C.F.R. 1.192(c):

(1) Real party in interest

The real party in interest is Trimble Navigation Ltd. ("Trimble"), a California Corporation having a place of business at 645 N. Mary Avenue, Sunnyvale, California. Trimble is a manufacturer of GPS receivers and related products, and is the assignee of record of the entire right, title and interest in and to the above-identified application by virtue of an assignment from the inventor.

(2) Related Appeals and Interferences

The appellant and its legal representatives know of no other appeals or interferences that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal. However, the appellant has another application, Serial No. 09/231,549, filed January 14, 1999, for "GPS Receiver Having a Rapid Acquisition of GPS Satellite Signals" under final rejection in Group 3662. That application is also one for reissue, and the sole ground of its rejection is alleged recapture. It is currently contemplated that, if that application is not allowed, a notice of appeal will be filed therein in due course.

(3) Status of Claims

The claims involved in this appeal are claims 1-59. No claims have been cancelled. The final Office Action, mailed May 16, 2000, states that claims 1-59 are rejected because they

“recapture claimed subject matter deliberately canceled in application serial Number 07/978,272.”¹

No claim presently stands rejected as unpatentable in view of prior art.

Claims 1-27 are identical to claims 1-27 in original Patent No. 5, 418, 537, of which reissue is sought. It is understood that the rejection of claims 1-27 would be withdrawn if claims 28-59 were either allowed or canceled.

Claims 1-49 were allowed over the prior art of record in an ex parte Quayle action mailed July 15, 1999. The allowability of claims 1-49 was withdrawn and the claims rejected in a nonfinal Office Action mailed October 20, 1999, the withdrawal being based solely upon alleged recapture, a rejection raised for the first time in this Office Action.

Claims 50-59 were presented for the first time by amendment filed January 27, 2000. These claims were rejected by the Final Office Action mailed May 16, 2000 on the sole basis of alleged recapture.

(4) Status of Amendments

A response after the final rejection was filed August 22, 2000. The response contained only remarks and argument concerning the issue of recapture; no claim amendments were proposed.

(5) Summary of Invention

In the following summary of the invention, reference is made to page/line numbers of the specification and to Fig./reference characters of the drawings.

¹ Application Serial No. 07/978,272 is the parent application to this application and issued as U.S. Patent No. 5,418,537 (hereinafter “‘537 patent”) with claims 1-27, presented identically in this application as claims 1-27 at issue.

In a preferred embodiment, the invention employs a GPS or other navigation system (1/6-9; Fig. 1/29A-C) for determining the location of a stolen or otherwise missing vehicle (1/11-14), a paging system (7/25-34; Fig. 4/19) that may be noncellular and sends a signal inquiring of the vehicle location, and a communications system that may be a cellular telephone capable of operation independent of the paging system (4/38-68; Fig. 4/23) and is carried on the vehicle for transmitting the location of the vehicle to a central station--for example, the vehicle owner or a police station (6/63-64). This can be done in a way that does not alert an occupant of the vehicle (5/9-20).

(6) Issues

The only issue presented is whether the recapture doctrine is a bar to the allowance of claims 1-59.

(7) Grouping of Claims

Claims 1-59 on appeal may, for purposes of the recapture issue, be grouped in three categories as follows:

A. Claims 1-27 are claims 1-27 of the '537 patent of which reissue is sought in the present application, and they have not been amended or changed in any way from the form in which they were issued; the recapture doctrine does not apply to these claims;

B. Claims 28-49, 54-55 and 58-59 all of which call for a communications device capable of operation independent of a paging request responder; and

C. Claims 50-53 and 56-57 all of which call for a noncellular paging request responder.

(8) Argument

Summary Of Argument

The recapture doctrine prevents a patentee from regaining through reissue subject matter deliberately surrendered in an effort to obtain allowance of the original patent claims. Ball Corp. v. United States, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984). Recapture does not apply to the facts of the present case because the applicant is not attempting to “recapture” anything he previously gave up. While reissue claims 28-59 here are broader than those canceled from the parent application in some respects, they are materially narrower in other respects: that is, they contain narrowing limitations that, in combination with the other recitations in the respective claims, led to their being declared patentable over the prior art. The claims of Group B above are narrower than any claim presented or canceled during prosecution of the parent application in that each calls for a communications device capable of operation independent of the paging request responder, a limitation not present in any previously canceled claim or claim feature. Similarly, the claims of Group C above are narrower than any claim presented or canceled during prosecution of the parent application in that each calls for a noncellular paging request responder, a limitation not present in any claim presented or canceled during the prosecution of the parent application. Accordingly, the reissue claims of Groups B and C do not encompass previously surrendered subject matter and, there being no art-based rejection, are allowable.

Detailed Argument

Claims 1-59 stand rejected in this application. Of these, claims 1-49 have been held patentable over the prior art. Claims 50-59 have not been explicitly allowed over the prior art but

are not subject to an art-based rejection and stand rejected solely on the basis of alleged recapture.

Preceding Section 2 on page 5 of the Final Office Action dated May 16, 2000, the Examiner stated the following two-pronged recapture rule: "A reissue claim cannot be broader than a canceled claim in all aspects, and all reissue claims must retain at least one of the reasons (limitations) which made the patent claims allowable" (emphasis in the original). With respect to the first prong, the Examiner compares reissue claim 28 to application claim 31 canceled from the parent application Serial No. 07/978,272 and concludes that reissue claim 28 is "broader in all aspects" (5/16/00 Office Action, Section 1, page 4)². The Examiner also compares reissue claim 30 with application claim 27 canceled from the parent application. He concludes that reissue claim 30 is impermissibly broader than application claim 27 in an aspect "directly related" to the rejection of application claim 27. The Examiner's exemplary comparison of reissue and canceled claims incorrectly states the conclusions to be drawn therefrom.

Applicant respectfully traverses the assertion that reissue claim 28 is "broader in all aspects" than application claim 31. Each of reissue claims 28-49, 54-55 and 58-59 (Group B) calls for a paging request responder and a communications device capable of operation independent of the

² The Examiner states (page 4 of the Final Office Action):

... claim 31 in the patent application was canceled (combined with claim 10 to form allowable claim 39, renumbered as claim 7). Comparing new claim 28 to canceled claim 31; it is broader in all aspects[.] The patented claim 7 required the subject matter of claim 10 to be allowable. Therefore, Applicant "surrendered" claimed subject matter not including the limitations of claim 10.

paging request responder, or a method employing such devices (see for example claim 28 as amended and the similar recitations in claims 29-33). Neither application claim 31, nor any other claim canceled from the parent application Serial No. 07/978,272, ever contained such a limitation. Therefore neither reissue claim 28, nor any other reissue claim of Group B, is “broader in all aspects” than application claim 31 or any other previously canceled claim.

The same is true of the reissue claims of Group C. Claims 50-53 and 56-57 specify a non-cellular paging request responder. No claim canceled from the parent application Serial No. 07/978,272 ever contained such a limitation.

Applicant also respectfully traverses the assertion that reissue claim 30 recaptures subject matter “directly related” to the rejection of original application claim 27. Original application claim 27 was rejected as unpatentable over U.S. Patent 5,043,736 to Darnell et al. (Office Action of February 22, 1994, page 2). In contrast, reissue claim 30 was not rejected as unpatentable over Darnell et al. but stood rejected over U.S. Patent 5,208,756 to Song (Office Action of March 16, 1998, page 2, Section 3) until it was amended to include the narrowing limitation that characterizes the claims of Group B.

The second prong of the Examiner’s recapture rule at Section 1, page 5 of the Final Office Action, namely that all reissue claims must retain at least one of the reasons (limitations) which made the patent claims allowable, sets a standard having no support in the statute or case law.³ A

³ Nevertheless, all of the reissue claims at issue here literally satisfy the second prong of the Examiner’s test. Here, all reissue claims recite, for example, at least one of the limitations defining the patentable combination of the claims of the ‘537 patent, such as paging requests, transmission of fixes, etc.

claim depends for patentability not upon any one limitation, but upon the unobviousness in view of the prior art of the combination of all limitations it recites. A patentable combination cannot be said to be patentable solely because of a particular limitation. Thus with reference to the Examiner's example, while claim 7 of the '537 patent depends upon a recitation of LORAN signals for patentability, it equally depends for patentability upon a recitation of providing a page responder, as recited at patent column 14, line 16, and a recitation of "causing the controller/modem to cause the cellular telephone to contact a selected vehicle location service or paging service and to communicate the information on the vehicle present location to the vehicle location service or paging service," as recited at patent column 14, lines 40-44, etc. While those features in combination with the other features of patent claim 7 define patentable subject matter, that in no way implies that every patentable claim must include the features of canceled application claim 10.

We need only examine claim 1 of the '537 patent to find proof of that. Patent claim 1 does not depend for patentability upon a recitation of LORAN signals. Instead, it depends for patentability upon a recitation of GPS signals, together with other features. There is no deconstruction of the claims and their file history that validates an assertion that the claims in this reissue application, in order to be patentable, must include the recitations of canceled claim 10, or of any other particular claim, of the original application.

The second prong of the Examiner's standard, moreover, implies that a reissue claim cannot be patentable for any reason except whatever reason made the original patent claims patentable. Neither the statute nor case law supports this notion. To the extent that a requirement is imposed that reissue claims include the limitations of the original patent claims, broadening reissues are

foreclosed, which is contrary to 35 U.S.C. §251. Moreover, any notion that reissue claims must be patentable for the same reason that the claims of the patent of which reissue is sought were patentable is refuted by the recent case of B. E. Meyers & Co. v. United States, 56 USPQ 2d 1110 (Ct. Cl. 2000), Exh. C. The court in Meyers held on a motion for summary judgment that there was no recapture, even though the claims in the reissue patent were in some respects much broader than those in the original patent. In Meyers, the reissue claims contained a limitation, not recited in any claim of the original patent, to a beam with a well-defined peripheral edge, but were broader than the patent claims because limitations to a pulsing circuit previously added to the patent claims to avoid prior art had been eliminated. These claims were held to be eligible for reissue patent protection because the narrowing limitations precluded the recapture of previously surrendered subject matter. Ibid at 1116.

The correct recapture analysis is to inquire whether the reissue claims include any narrowing limitation not present in claims deliberately canceled from the parent application, and, if so, to determine whether that narrowing limitation is material. Applicant submits that the court in Hester Industries Inc. v. Stein Inc., 142 F.3d 1472, 46 USPQ 2d 1641 (Fed. Cir. 1998) applied a correct analysis. The court said that despite the fact that the reissue claims had been broadened in some respects "...because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects." Hester Industries, 46 USPQ 2d at 1649. The situation here is similar to that in Ball Corp., supra. There, the reissue claims contained narrowing limitations not present in previously canceled claims but were broader than the canceled claims in other respects. Referring to those reissue claims the court said: "As noted supra, there is

widespread agreement that reissue claims that are narrower than the canceled claims are allowable.” Ball Corp., 729 F.2d at 1438. Recapture was avoided in Ball Corp. “because the reissue claims were sufficiently narrowed...” Hester Industries, 46 USPQ 2d at 1649. Thus, under Ball Corp. supra, if a reissue claim is narrower in a material aspect than claims canceled from the parent application, the recapture rule does not bar the claim, even if the reissue claim is broader in a different aspect.

Here the reissue claims of Groups B and C contain limitations that make them narrower in a material respect than the claims canceled from parent application serial No. 07/978,272. The allowance of claims 28-49 in the ex parte Quayle communication is an acknowledgment by the PTO that the “independent operation” feature of the claims of Group B has a material aspect to it. If this feature of the invention were incidental or mere verbiage its insertion into the reissue claims would not have led to their allowance. Nor is it simply inherent that the communications device of these claims be capable of operation independent of the paging request responder. The communications device can easily be placed under the control of the paging request responder as required by the claims of the original patent, and incapable of independent operation as, for example, is shown by the reference to Song, of record.

Claims 50-59, like claims 1-49, have also not been rejected as unpatentable over the prior art. Thus, the “noncellular” feature of the claims of Group C also has a material aspect to it. If the “noncellular” feature of the invention were incidental or mere verbiage its insertion into the reissue claims would not have avoided their rejection as unpatentable over the prior art. Nor is it inherent that the communications device of these claims be “noncellular”. Both a signal inquiring of the location of a missing vehicle and a signal transmitting the location of the vehicle can easily in

principle be cellular. It cannot be said that the limitations in the reissue claims of either Group B or Group C are incidental or mere verbiage or recite only inherent properties of what is otherwise claimed.

Except for Ball Corp., which the Examiner cites but doesn't discuss, the cases cited and relied upon by the Examiner deal with circumstances in which the reissue claims are, on the whole, of the same scope as or broader than claims previously canceled. Neither circumstance applies here. Reissue claims 1-27 (Group A), copied verbatim from the '537 patent, were obviously not canceled from the parent application, and claims 28-59 (Groups B and C) appear for the first time in this reissue application. Neither claims 28-59 nor claims having a scope equal thereto were ever presented in, or canceled from, the parent application. While claims 28-59 are broader in some aspects, they contain material narrowing limitations not present in claims canceled from the parent application. It is elementary that if one claim recites features ABC and another recites features BCD, neither claim contains or encompasses the other. It cannot be validly asserted that claims 28-59 are broader than claims canceled from the parent application.

In re Clement, 131 F.3d 1464, 45 USPQ 2d 1161 (Fed. Cir. 1984) cited in MPEP §1412.02 is inapposite on its facts. There, limitations of the same type, e.g. temperature and specific mechanical energy, were broadened. Here, totally new limitations (including the features of Groups B and C) have been introduced, making the reissue claims patentable for reasons other than the original reasons for patentability. The material narrowing limitations of the reissue claims of Groups B and C were never present in any canceled claim. There can be no recapture and reissue claims 1-59 are unquestionably allowable.

Conclusion

The applicant does not seek in this application to recapture any subject matter canceled from the parent application. The Examiner erroneously included reissue claims 1-27, as copied from the '537 patent, in the recapture rejection. While reissue claims 28-59 are broader in some respects than those canceled from the parent application, they are all narrower in material respects. No claim of the scope of now-pending claims 28-59 was ever presented in the application resulting in the '537 patent. All of the pending reissue claims are narrower in material respects than all of the claims canceled from the application resulting in the '537 patent. Applicant never canceled or surrendered claims having the scope of claims 28-59, and recapture is therefore not possible. The recapture doctrine as erroneously applied by the Examiner would likely bar all broadening reissues, which is contrary to the statute. Accordingly, it is respectfully requested that the decision of Examiner finally rejecting claims 1-59 based upon the recapture doctrine be reversed.

Respectfully submitted,
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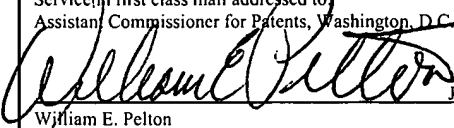
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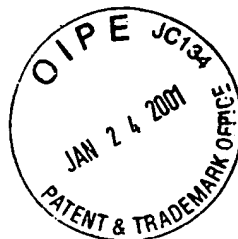

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(9) APPENDIX TO BRIEF ON APPEAL

This appendix sets out a copy of the claims involved in the appeal as Exhibit A, including claims 1-27 identical to the claims in original '537 patent and claims 28-59 added in this reissue application. Also included in the Appendix as Exhibit B is a copy of the '537 patent. Exhibit C is



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a copy of the Court of Claims decision in B.E. Meyers & Co. v. United States, 56 USPQ 2d 1110
(Ct. Cl. 2000).

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